

indefinite about the phrase used due to the fact that generic claiming and use of broad terminology is specifically allowed under the rules (see e.g. MPEP § 2173.04 entitled "Breadth Is Not Indefiniteness" and MPEP § 2163.05), Applicant has nevertheless removed the limitation not based on the indefiniteness rejections, but because Applicant has understood the Patent Examiner's point regarding the use of a semi-solid paste as a color pellet as discussed in Collins et al., and accordingly has changed this language to something that is more clearly directly against the teachings of Collins et al. In particular, "shapeless amorphous form" has been deleted and changed to a method which involves a plurality of pigments "in bulk form that are free of pre-measured individual units" (i.e. free of pellets). It is submitted that this is an inherent characteristic of the pigments described in the specification. See e.g. the description of measuring a frost pigment in powdered form at page 8, lns. 5-8 and that the pigments 24 are provided in bulk form in containers. (FIG. 1); see also e.g. page 7, lns. 16-18 and how the pigments 24 are poured onto a blending sheet in the preferred embodiment to obtain measured quantities at page 6 generally. Accordingly, it is believed that the indefiniteness rejections are moot although Applicant reserves the right to reintroduce the shapeless amorphous form at a later date, if desired, based on the above comments.

Turning to the prior art rejections, Applicant has amended claims 7, 14, 19 and 26 to more clearly differentiate the cited prior art and believes that the amendments more clearly obviate the prior rejections based on Collins et al. It is respectfully submitted that claim 1 in its present form already patentably defines over the combination of prior art references cited by the Patent Examiner.

Turning to the rejections of claims 1-6, they have been rejected as obvious over Collins et al. in view of Beal, Jr. The rejection is respectfully traversed. In particular, claim 1 sets up a specific order with two uses of the word "thereafter" at strategic locations in the claim. With this strategic order, importantly, the step of applying the base pigment mixture to lips of the person for evaluation is conducted before the heating of the base pigment mixture and the subsequent cooling of the base pigment mixture in a mold. This specific order limitation is not taught or discussed anywhere in the prior art references and in fact are directly against the teachings of the cited prior art references and therefore the obviousness rejection fails to establish prima facie case of obviousness under MPEP § 2143 and § 2143.01. Specifically, Beal, Jr. discusses the fact that numerous samples of existing lipsticks are displayed behind the counter at a retail store and are already finished product. See e.g. Col. 1, ¶s 2-3. The only fair reading of Beal, Jr. is that the subject lipstick applicator is used to select an already solidified hardened lipstick, nothing more. Collins et al. specifically

teaches that the operator has to only count out the different color pellets to be added to a predetermined formula and then add the required number of doses to the oil blend as dictated by the same formula. See e.g. paragraph joining Cols. 3 and 4. Nowhere in Collins et al. does it disclose or suggest applying the base pigment mixture to the lips of the person for evaluation between a softening and mixing step and a subsequent heating and cooling step which is clearly established in claim 1 by the use of the phrase "thereafter". This is important because contrary to the prior art the present invention allows for adjustment of the base pigment mixture if necessary and if the desired shade is not achieved. No such provision is provided in Collins et al. for such an adjustment possibility and even further in Beal, Jr., the subject paper sheets have lipstick produce that correspond to an already finished lipstick product, not a product that is being currently made and adjusted if necessary.

Further, the differences between the claims and prior art appear in claims 2 and 3 which discuss adding at least one pigment after the step of the applying to adjust the base pigment mixture. Nowhere is this discussed or taught in either Beal, Jr. or Collins et al. Accordingly, Applicant respectfully requests the obviousness rejections of claims 1-6 to be withdrawn.

For similar reasons as set forth above, it is submitted that the rejections of claims 19-20, 22-25 and 29 should be withdrawn because these references fail to teach the repeating step discussed in these claims. Although the rejections are further based on Lombardi et al, Lombardi et al. does not cure the deficiencies of Collins et al. or Beal, Jr. In fact, Lombardi et al. teaches the exact opposite as can be gleaned from the abstract that "the method includes selecting a **final color** and identifying a combination of pellets to create the final color upon combination thereof" (emphasis added). This is also shown in FIG. 1 of Lombardi et al. where the final color is selected as the first initial step and there is never any adjustment of the color during the process of making a lipstick. Thus, Lombardi et al. would tend to teach directly away from the present invention because Lombardi explicitly teaches one should first select the final color which inherently avoids the repeating the selecting measuring and mixing steps as claimed in claims 19-20, 22-25 and 29. Accordingly, Applicant respectfully requests removal of the obviousness rejections against these claims and also claims 30-33 for similar reasons.

Finally, Applicant has understood the Patent Examiner's point about use of a "semisolid paste as color pellets" as arguably meeting the shapeless amorphous form limitation. To avoid argument about definitions and without acquiescing, independent claims 7, 14, 19 and 26 have been amended to more clearly differentiate the cited Collins et al. reference and therefore it is submitted that the prior art rejections of these claims based upon

Collins et al. are clearly obviated. Specifically, Collins et al. specifically teaches the use of color pellets whether is be in semisolid paste form or solid form. Importantly, the Collins et al. reference specifically states that "the term pellet is used herein to describe a color unit of a known predetermined weight or volume. . .". Col. 3, lns. 36-38. Also explicitly disclosed in Collins et al., importantly, "gravimetric measurements of ingredients are not required" and "the operator has only to count out the different color pellets to be added according to a predetermined formula and then add the required number of doses to the oil blend as dictated by the same formula". Col. 3, ln. 65-Col. 4, ln. 2. In direct contrast to Collins et al., the amended claims recite a method which involves "a plurality of pigments in bulk form that are free of pre-measured individual units" (emphasis added) and recites a measuring step rather than a counting step. This is in direct contrast to Collins et al. which specifically teaches use of pre-measured units, i.e. pellets, which are of a "known predetermined weight or volume". Col. 3, ln. 38. Thus, Collins et al. has nothing to do with measuring quantities of selected pigments with a measuring device.

The reference to a metered dose system as discussed in Col. 3, second to last paragraph of Collins et al. is inapposite and merely discusses how the color pellets are made, not how lipsticks are made. In particular, as an example, claim 7 recites selecting various pigments "based upon the customer demand" and measuring quantities of "selected pigments". This makes it clear that the "selecting" and "measuring" are performed after a customer demand is received. In stark contrast, the metered dose system is used to create the pellets, not used to mix selected pigments which are based upon a customer demand that has been received. Accordingly, Applicant respectfully requests that the rejections of claims 7-33 be withdrawn for these reasons.

If that is not enough, claims 37-41 have been added which specifically recite that the method is accomplished without counting pellets. This is directly against the teachings of Collins et al. which specifically requires counting pellets(see e.g. Col. 3, lns. 66-67) and really brings to light the fact that Collins et al. is involved with counting pre-measured pellets, not measuring selected pigments which are not in individually separated pre-measured units.

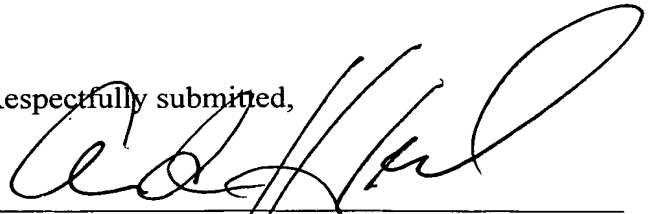
Finally, claims 42-46 also differentiate Collins et al. in that it discusses use of at least one pigment in powder form in the method. Collins et al. teaches use of solid or semi-solid pellets, not use of powders and therefore these claims are separately patentable and should be allowed for this additional reason.

Finally, none of the references teach or disclose use of blending sheets or graduated blending sheets. Accordingly, claims 10, 18, 20, 21, 34 and 35 are separately

In re Appln. of Mary Swaab  
Application No. 09/714,318

patentable for this further reason. In view of the foregoing, Applicant respectfully requests withdrawal of all outstanding rejections and the issuance of a Notice of Allowance. The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



---

Andrew J. Heinisch, Reg. No. 43666  
LEYDIG, VOIT & MAYER, LTD.  
6815 Weaver Road, Suite 300  
Rockford, Illinois 61114-8018  
(815) 963-7661 (telephone)  
(815) 963-7664 (facsimile)

Date: August 29, 2003